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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/087,897	03/01/2002	Andrew Perkins	A-71304/ESW	4526
7590	01/15/2004		EXAMINER	
FLEHR HOHBACH TEST ALBRITTON & HERBERT LLP Suite 3400 Four Embarcadero Center San Francisco, CA 94111-4187			HUYNH, LOUIS K	
			ART UNIT	PAPER NUMBER
			3721	
			DATE MAILED: 01/15/2004	
				13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/087,897	PERKINS ET AL.	
	Examiner	Art Unit	
	Louis K. Huynh	3721	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 26 September 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 8-12 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-7 and 13-20 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 29 September 2003 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>10</u> . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Election/Restrictions

1. Claims 1-20 are pending in the present application. Applicant has elected without traverse Claims 1-7, 13-20 in Paper No. 8 for examination on the merits. Claims 8-12 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention.

Drawings

2. The formal drawings were received on September 29, 2003. These drawings are approved.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 4, 7, 16, 17, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simhaee (US 6,423,166) in view of Skalsky et al. (US 4,936,079).

Simhaee discloses a machine for making air-filled packing cushions from a roll (39) of prefabricated film material having two layers (10 and 16) that are sealed together to form a longitudinally extending inflation channel (15) near one edge of the material, a plurality of chambers (12) to one side of the channel (15), and inlet passageways (14) extending laterally between the inflation channel (15) and the chambers (12), including an air injector (30) position for directing air via the inflation channel (15) to inflate the chambers (12); a sealing unit (36, 38)

for forming a longitudinal extending seal across the inlet passageways (14) (column 3, lines 41-54); and means (conventional rollers) for feeding the film material (column 3, lines 34-37). The apparatus of Simhaee meets all of applicant's claimed subject matter but lacks the specific teaching of a pair of spaced apart, horizontally extending rollers on which the roll of film material rests. However, Skalsky discloses a known roll support assembly including a pair of spaced apart, horizontally extending rollers (84) for supporting a roll of material (154) so that loading of new material can be performed with the least time consuming. Therefore, it would have been obvious to a person with an ordinary skill in the art, at the time the invention was made, to have modified the apparatus of Simhaee by having provided a pair of spaced apart, horizontally extending rollers, as taught by Skalsky, in order to support the roll of material and to facilitate loading and unloading the roll of material with the least time consuming.

With respect to claim 7, Simhaee teaches a method of making air-filled packing cushions from a roll of prefabricated film material (39) including the steps of: feeding the film material from the roll to the air injector (30); introducing air into the chambers (12) of the film material through the air injector (30) via the inflation channel (15) to inflate the chambers (12); and forming a longitudinally extending seal across the inlet passageways (14) between the inflation channel and the chambers (12). The method of Simhaee meets all of applicant's claimed subject matter but lacks the specific teaching of the step of resting the roll of film material on a pair of spaced apart, horizontally extending rollers. However, Skalsky discloses a known method of supporting a roll of material using a roll support assembly including a pair of spaced apart, horizontally extending rollers (84) for supporting the roll of material (154) so that loading of new material can be performed with the least time consuming. Therefore, it would have been obvious

to a person with an ordinary skill in the art, at the time the invention was made, to have modified the method of Simhaee by having provided a step of resting the roll of film material on a pair of spaced apart, horizontally extending rollers, as taught by Skalsky, so that the roll of film material can be placed on the roll support and ready to be dispensed with the least time consuming.

Regarding the limitations of the air injector being positioned below and extended in an upward direction with respect to the support rollers and the film material being fed in a generally downward direction, the modified machine and method of Simhaee deems to satisfy the structural relationships in the manner as claimed when the modified machine and method of Simhaee schematically illustrated in FIG. 5 is viewed from the bottom of the page.

With respect to claims 16, 17, 19 and 20, the inflation channel (15) of the roll (39) of material would have been pinched closed by one of the support rollers in the modified machine and the arrangement of the roll of material on the support rollers is obvious as a matter of engineering design choice since it does not solve any stated problem insofar as the record is concerned and thus does not patentably distinguish the claimed invention over the applied prior art.

5. Claims 2, 3, 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over the applied prior art as applied to claims 1 and 4 above; and further in view of Larson et al. (US 4,017,351).

The modified machine of Simhaee including the sealing unit (36, 38) which meets most of applicant's claimed subject matter but lacks the specific teaching of the sealing unit including a stainless steel cylindrical heating element and a wheel urged together. However, sealing unit

including a stainless steel heating element and a wheel urged together is well known in the art; for example, Larson discloses a device for providing air inflated cushioning material including a cabinet (30) for supporting the working elements of the device and a sealing unit including a stainless steel heating element (44) and a wheel (41) cooperating to heat seal the inlet passageways (20) of the cushioning material (12). Therefore, it would have been obvious to a person with an ordinary skill in the art, at the time the invention was made, to have further modified the machine of Simhaee by having provided a heating unit comprising a stainless steel heating element and a wheel, as taught by Larson, in order to seal the inlet passageways between the inflation channel and the chambers. The modified machine of Simhaee in view of Larson meets all of applicant's claimed subject matter but lacks the specific teaching of the heating element being a cylindrical in shape. However, the specific shape of the heating element is obvious as a matter of engineering design choice since it does not solve any stated problem insofar as the record is concerned and thus does not patentably distinguish the claimed invention over the applied prior art.

6. Claims 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simhaee (US 6,423,166) in view of Skalsky et al. (US 4,936,079); and in view of Larson et al. (US 4,017,351).

Simhaee discloses a machine for making air-filled packing cushions from a roll (39) of prefabricated film material having two layers (10 and 16) that are sealed together to form a longitudinally extending inflation channel (15) near one edge of the material, a plurality of chambers (12) to one side of the channel (15), and inlet passageways (14) extending laterally

between the inflation channel (15) and the chambers (12), including an air injector (30) position for directing air via the inflation channel (15) to inflate the chambers (12); a source of air connected to the air injector (inherent); a sealing unit (36, 38) for forming a longitudinal extending seal across the inlet passageways (14) (column 3, lines 41-54); and means for feeding the film material (column 3, lines 34-37). The apparatus of Simhaee meets all of applicant's claimed subject matter except for a pair of spaced apart, horizontally extending rollers on which the roll of film material rests. However, Skalsky discloses a known roll support assembly including a pair of spaced apart, horizontally extending rollers (84) for supporting a roll of material (154) so that loading of new material can be performed with the least time consuming. Therefore, it would have been obvious to a person with an ordinary skill in the art, at the time the invention was made, to have modified the apparatus of Simhaee by having provided a pair of spaced apart, horizontally extending rollers, as taught by Skalsky, in order to support the roll of material and to facilitate loading and unloading the roll of material with the least time consuming.

Regarding the limitations of the air injector being positioned below and extended in an upward direction with respect to the support rollers and the film material being fed in a generally downward direction, the modified machine of Simhaee deems to satisfy the structural relationships in the manner as claimed when the modified machine of Simhaee schematically illustrated in FIG. 5 is viewed from the bottom of the page.

The modified machine of Simhaee including the sealing unit (36, 38) which meets most of applicant's claimed subject matter but lacks the specific teaching of the sealing unit including a stainless steel cylindrical heating element and a wheel urged together, and a cabinet. However,

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cabinet and sealing unit including a stainless steel heating element and a wheel urged together is well known in the art; for example, Larson discloses a device for providing air inflated cushioning material including a cabinet (30) for supporting the working elements of the device and a sealing unit including a stainless steel heating element (44) and a wheel (41) cooperating to heat seal the inlet passageways (20) of the cushioning material (12). Therefore, it would have been obvious to a person with an ordinary skill in the art, at the time the invention was made, to have modified the machine of Simhaee by having provided a cabinet and a heating unit comprising a stainless steel heating element and a wheel, as taught by Larson, in order to support the working elements of the machine and to seal the inlet passageways between the inflation channel and the chambers. The modified machine of Simhaee in view of Larson meets all of applicant's claimed subject matter but lacks the specific teaching of the heating element being a cylindrical in shape. However, the specific shape of the heating element is obvious as a matter of engineering design choice since it does not solve any stated problem insofar as the record is concerned and thus does not patentably distinguish the claimed invention over the applied prior art.

Regarding the limitation of the source of air being within the cabinet, the arrangement of the source of air is obvious as a matter of engineering design choice since the location of the source of air does not solve any stated problem insofar as the record is concerned and thus does not patentably distinguish the claimed invention over the applied prior art.

7. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over the applied prior art as applied to claims 4 above; and further in view of Murakami (US 5,581,983).

The modified machine of Simhaee meets all of applicant's claimed subject matter but lacks the specific teaching of the means for feeding the film material including dual feed rollers positioned on opposite sides of the inflation tube. However, Simhaee teaches that conventional rollers could be used for feeding the material (column 3, lines 34-37). Furthermore, Murakami discloses a gas injection device for making cushioning material including an air inflation tube (23) and dual feed rollers (21) positioned on opposite sides of the inflation tube for feeding the film material (12) through the inflation tube. Therefore, it would have been obvious to a person with an ordinary skill in the art, at the time the invention was made, to have further modified the machine of Simhaee by having provided dual feed rollers, as taught by Murakami, in order to feed the film material through the air injector.

Response to Arguments

8. Applicant's arguments filed September 26, 2003 have been fully considered but they are not persuasive.

With respect to Claims 1, 7 and 13, applicant contends that there is no motivation or basis for combining the support rollers of Skalsky into the machine of Simhaee other than applicant's own disclosure and claims. This is not found persuasive because supporting a roll of material on a pair of spaced apart rollers is well known for its ability to facilitate material changing; thus, the motivation for combining the support rollers of Skalsky into the machine of Simhaee.

Regarding the limitations of the air injector being positioned below and extended in an upward direction with respect to the support rollers and the film material being fed in a generally downward direction, the modified machine of Simhaee deems to satisfy the structural

relationships in the manner as claimed when the modified machine of Simhaee schematically illustrated in FIG. 5 is viewed from the bottom of the page.

With respect to Claims 2, 3, 5, 6, 14 and 15, the specific shape of the heating element is obvious as a matter of engineering design choice since it does not solve any stated problem. One of ordinary skill in the art would have expected applicant's invention to perform equally well with the stainless steel belt of Larson. Therefore, it is not patentably distinguish the claimed invention over the applied prior art.

With respect to Claims 16 and 19, the roll of material in the modified machine of Simhaee would have been supported by the support rollers and the weight of the roll would have exerted a force against the roller to pinch closed the inflation channel.

With respect to Claims 17 and 20, the arrangement of the support rollers such that the material is withdrawn from the roll about 90 to 180 degrees from the point where the inflation channel is pinched by the rollers is obvious as a matter of engineering design choice since it does not solve any stated problem. One of ordinary skill in the art would have expected applicant's invention to perform equally well with the support rollers being arranged anywhere with respect to the air injector. Therefore, it is not patentably distinguish the claimed invention over the applied prior art.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

10. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

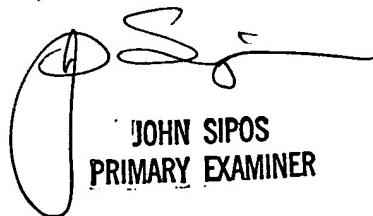
MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Louis K. Huynh whose telephone number is (703) 306-5694. The examiner can normally be reached on M-F from 9:30AM to 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I. Rada can be reached on (703) 308-2187. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9302.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

LH
January 12, 2004



JOHN SIPOS
PRIMARY EXAMINER